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WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400 - INTERNATIONAL CENTRE
900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402-3319

EXAMINER

SHEWAREGED, BETELHEM

ART UNIT PAPER NUMBER

1774

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,589

Applicant(s)

MARENTIC ET AL.

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9,10 and 39-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9,10 and 39-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response filed on 01/09/2006 has been fully considered. The 35 USC 103 rejection has been withdrawn in view of Applicant's amendment. The 35 USC 102 rejection has been modified to include claims 44, 45 and 47-49 in the rejection.

2. Claims 1, 9, 10, 39 and 40 are amended, claims 2, 3, 8 and 11-38 are cancelled, claims 41-49 are added, and claims 1, 4-7, 9, 10 and 39-49 are pending.

Claim Rejections - 35 USC § 102

3. Claims 44, 43 and 47-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamauchi et al. (US 5,387,013).

Yamauchi discloses a transfer media comprising a substrate, a design layer and an adhesive layer, wherein the design layer comprises carbon black (Fig. 5, col. 4, line 50 and col. 31, line 17). The design layer is equivalent to the claimed ink film, the adhesive layer is equivalent to the claimed tacky resin, and the carbon black is equivalent to the claimed pigment.

New Rejection

Claim Objections

4. Claims 6, 7 and 46 are objected to because of the following informalities:

- a. Claims 6 and 7 are dependent up on canceled claim 2.
- b. In claim 7, the word "isophthallic" is misspelled as ---isophthallic---.

- c. Claim 46 is identical to claim 10.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4, 6, 7, 9, 10 and 39-49 rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al. (US 5,643,659), as evidenced by Rinz (US 6,040,391) and List of Organic Solvent Copolyester resins (Internet Printout).

Kobayashi discloses a transfer sheet comprising a substrate sheet, a coloring layer comprising a coloring agent and a hot-melt binder, and a metallic ink layer comprising a metallic pigment and a hot-melt binder (abstract). The coloring layer is equivalent to the claimed first layer and the metallic ink layer is equivalent the claimed second layer. Both the coloring layer and the metallic layer comprise polyester as the binder (20l. 2, line 62 and col. 3, line 44). The amount of coloring agent in the coloring layer is 5-100 parts by weight for 100 parts by weight of the binder (col. 3, line 29). In the Examples the binder used in the metallic layer is polyester of Vylon 200 manufactured by Toyobo Co., Ltd., wherein this polyester has adhesive property, which is evidenced by List of Organic Solvent Copolyester resins. With respect to claims 7 and 43, polyester is a condensation product of polybasic acid such as isophthalic acid

and polyol such as neopentyl glycol, and this is evidenced by Rinz (see col. 2, lines 35-59 of Rinz).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 5,643,659).

Kobayashi does not disclose the use of a release liner over the metallic ink layer. However, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to cover the adhesive layer of Kobayashi with a release liner so as to keep the metallic ink layer from being damaged while handling and/or storing. Protecting an outer layer with a release liner is well known in the transfer medium art.

Response to Arguments

9. Applicant's arguments with respect to claims 1, 5 and 9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1774

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B.S.
March 24, 2006.


BETLEHEM SHEWAREGED
PRIMARY EXAMINER